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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,715	12/30/2003	Thomas Odorzyński	19197 (27839-2575)	2119
45736	7590	12/09/2009	EXAMINER	
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ART UNIT	PAPER NUMBER			3688
NOTIFICATION DATE	DELIVERY MODE			
12/09/2009	ELECTRONIC			

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/748,715
Filing Date: December 30, 2003
Appellant(s): ODORZYNSKI, THOMAS

Christopher M. Goff
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 11 September 2009 appealing from the Office action mailed on 18 March 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,481,758	Gabler	01-1996
WO 03,023,496	Iwamoto	04-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims: This is a copy of the final rejection mailed on 18 March 2009.

Claims 1, 3, 6, 8, 12, 14-17, 20, 22, 25, 26, 28, 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Gabler (US pat. 5,481,758).

Claims 1, 3, 8, 14, 20, and 22: Gabler discloses a system and method for advertising, comprising:

a. selling space on underwear, which reads on a disposable diaper, to a sponsor (column 2, lines 25-29 and col. 2 lines 57-60);

b. placing an ad a product other than disposable diapers onto the disposable diaper (Fig. 3 and column 5, lines 39-57 teaches placing ad and column 2, lines 55-60); and

c. selling the disposable diapers to customers (column 1, lines 30-35).

The Examiner notes that little, if any, patentable weight is given to the type of clothing onto which the advertisements are applied. The disclosure in Gabler that the advertisements could be applied to children's clothing seen only in private, such as sleep wear, novelty underwear, etc. would also inherently encompass disposable diapers and disposable diapers along with all other forms of underwear.

Claims 6, 12, and 28: Gabler discloses a system and method as in Claims 1, 8, and 22 above, and further discloses printing the ad onto the disposable diaper (column 4, lines 65-67).

Claim 15: Gabler discloses a method as in Claim 14 above, and further discloses manufacturing the disposable diapers (by citing that the advertisers pay manufacturers of articles of clothing) (column 1, lines 25-29). (Also, inherent, since there must be a manufactured the disposable diaper before the advertisement can be placed thereon.)

Claims 16, 17, 25 and 26: Gabler discloses a system and method as in Claims 14 and 22 above, and further discloses that the ad may pertain to the article of clothing (disposable diaper) (by placing an advertisement for jeans on a pair of jeans) or not. Gabler discloses that "the content of the messages which is applied is limited only the imagination of persons making the message garment" (column 3, line 2-9). The Examiner also notes that little, if any, patentable weight is given to the product or type of product being advertised by the ad. It is inherent, as disclosed by Gabler that any message may be placed on the article of clothing (disposable diaper).

Claims 31 and 32: Gabler teaches the further limitation that the promotion is in the form of a "code" as noted for claims 14 and 22, because the broadest reasonable interpretation of "code" is any writing. (Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). The specification gives no explanation for "code".)

Claims 4, 5, 7, 10, 11, 13, 18, 24, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabler (5,481,758) in view of Iwamoto (WO 03/023496).

Claims 4, 5, 10, 11, 24, and 27: Gabler discloses a system and method as in Claims 1, 8, and 22 above, but does not explicitly disclose placing a plurality of ads on the disposable diaper. However, Iwamoto discloses a similar system and method for advertising on clothing that places a plurality of advertisements on the front, back, sides, etc. of the clothing (Abstract and Figures 1 and 17). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gabler to place one or more additional advertisements on the front, back, sides, or other desired place on the disposable diaper. One would have been motivated to place more than one ad on the disposable diaper in order to increase revenue for the manufacturer since each advertiser would be paying for the ad placement.

Claims 7, 13, and 29: Gabler discloses a system and method as in Claims 1, 8, and 22 above, but does not explicitly disclose attaching a detachable ad to the disposable diapers. However, Iwamoto discloses a similar system and method for advertising that discloses the ad may be printed onto the clothing or attached in a plurality of detachable manners (Abstract and Figures 2-16). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gabler to detachably attach the ad to the disposable diaper. One would have been motivated to use a detachable ad in order to allow the user to retain the ad after the disposable diapers were used.

Claim 18: Gabler discloses a method as in Claim 14 above, but does not explicitly disclose that the commercial advertisement on the disposable diaper is a coupon. However, a coupon is one well known type of commercial advertisement that has been detachably attached to products for many years. Thus, taken with the disclosure in Iwamoto of using detachable advertisements as discussed above, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a coupon as the advertisement or as part of the advertisement. One would have been motivated to include a (detachable) coupon in order to entice the customer to purchase the advertised product (whether it was for more disposable diapers or some other product).

With respect to claim 33, Gabler in view of Iwamoto addressed by the rejection as cited above.

(10) Response to Argument

Appellant argued in pages 4-14, that Gabler fails to disclose applying the paper money or any other design or graphic on a disposal diaper as required by the applicant. Additionally, appellant argued that nowhere, however, is there any teaching of disposable diapers being included in the children's underwear and disposable diapers are structurally different than underwear, as they typically include an absorbent pad, a bodyside liner, material/liquid previous topsheet, and liquid impervious barrier layer/backsheet.

However, the examiner respectfully disagrees with the appellant for the following reasons:

a) Gabler discloses using an article of clothing that is only seen in private such as underwear including panties and boxer shorts (column 2, lines 57-60). A definition for underwear is "clothing worn next to the skin under outer clothes" (see <http://dictionary.reference.com/browse/underwear>). Similarly, a definition for diaper is "a piece of cloth... worn as underpants..." (see <http://dictionary.reference.com/browse/diaper>). Therefore, given the broadest reasonable interpretation of both underwear and diaper, and given that a diaper is typically worn next to the skin under outer clothes and usually only seen in private, one of ordinary skill in the art would consider a diaper as underwear. Thus, the examiner respectfully submits that Gabler does teach placing an ad on a disposable diaper (column 2, lines 57-60; column 4, lines 65-67).

b) The examiner considers the structure of the diaper recited in claim 33 as admitted prior art by the appellant. See pages 7-8 of the Remarks filed January 13, 2009, where appellant argued "As well known in the art... disposable diapers... have layered construction." In the same pages, appellant cited a definition for disposable diapers as well as four U.S. patents as evidence that the structure of the diaper recited in claim 33 is well known in the art. Also see page 5 of the Supplemental Appeal Brief filed September 11, 2009, where appellant argues that "as is well known in the art, disposable diapers... typically include... an absorbant pad, a bodyside liner... and a... backsheet." Thus, the examiner respectfully submits that the structure of the diaper claimed in claim 33 is old and well known in the art.

c) Furthermore, the structure of the diaper as recited in claim 33 does not impact the manipulative steps of the method and is therefore, given little patentable weight. (See Ex parte Pfeiffer, 135 USPQ 31 (Bd. Apps 1961)) For example, the way claim 33 currently recites the step of "providing a diaper... comprising: a... pad, a... liner, and a... backsheet" does not affect the step of "placing an ad...onto the disposable diaper." While appellant argues on page 6 of the Supplemental Appeal Brief that the structure of the disposable diaper "...requires different steps of attaching an advertisement or promotion to the article," none of these particular steps are ever claimed. Similarly, while appellant argues on page 6 of the Supplemental Appeal Brief that "... the means for attachment is not necessarily the same for a cotton garment such as the pocket tee or underwear of Gabler as compared to the impervious backsheet or film of a disposable diaper as required by Applicant's claimed invention," Examiner respectfully submits that the particular "means for attachment" required by the structure of the diaper is not claimed. All that is claimed is *placing* an ad onto the disposable diaper. Accordingly, appellant is arguing limitations not currently recited in the claims.

In conclusion, appellant's arguments are fully considered, but deemed unpersuasive.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte dismissal of the appeal* as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Saba Dagnew/
Patent Examiner, Art Unit 3688

/C. Michelle Tarae/
Primary Examiner, Art Unit 3688

Conferees:

CMT

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Appeals Conference Specialist